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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/703,277	10/31/2000	Harrison G. Purvis	24104A	1667

27975 7590 12/10/2003

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EXAMINER

MILLER, WILLIAM L

ART UNIT PAPER NUMBER

3677

DATE MAILED: 12/10/2003.

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/703,277

Applicant(s)

PURVIS ET AL.

Examiner

William L. Miller

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 2 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on Board remand 08-01-2003.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☒ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-22 is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Reissue Applications***

1. Applicant is reminded of the continuing obligation under 37 CFR 1.178(b), to timely apprise the Office of any prior or concurrent proceeding in which Patent No. 5,842,685 is or was involved. These proceedings would include interferences, reissues, reexaminations, and litigation.

Applicant is further reminded of the continuing obligation under 37 CFR 1.56, to timely apprise the Office of any information which is material to patentability of the claims under consideration in this reissue application.

These obligations rest with each individual associated with the filing and prosecution of this application for reissue. See also MPEP §§ 1404, 1442.01 and 1442.04.

### ***Allowable Subject Matter***

2. Claims 1-22 are allowed.

3. The following is an examiner's statement of reasons for allowance: The recapture rejection of record under 35 U.S.C. §251 is hereby rescinded in view of a precedential opinion of the Board of Patent Appeals and Interferences (BPAI), namely *Ex parte Eggert*, Appeal No. 2001-0790 (Bd. Pat. App. & Inter. May 29, 2003). The recapture rejection is inappropriate based on the following analysis.

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Original independent claim 1 in the parent application included the broad limitation of:

*“a means for rotatably connecting said rails to said stanchions (emphasis added).”*

The following limitations of dependent claims 2, 3 and 4 were all added to the “rotatably connecting means” of claim 1 to obtain allowance of the patent claims in the original application for patent:

“said connecting means including a first threaded stud outwardly projecting from a top end of said stanchions in substantially axial alignment therewith enabling each of said upper side rails to be rotatably mounted thereon at various angles (limitations of claim 2),

said upper side rails being pivoted in a vertical plane at varying angles by use of angulation means (limitations of claim 3),

said angulation means comprising a generally L-shaped swivel bracket disposed on said first threaded stud at said top end of said stanchions, said L-shaped bracket including a long leg portion and a short leg portion being fixedly attached in perpendicular relation thereto, said bracket further including swiveling means being adapted for pivoting movement in a plane parallel to the plane defining said long leg portion, said swiveling means including a second threaded stud disposed in perpendicular relation to said axis of said stanchion enabling said upper side rails to be mounted thereon and pivoted in a vertical plane at varying angles for installation of said temporary guardrail system on inclines such as stairs. (limitations of claim 4)”

The above limitation has been modified in the only independent reissue claim, claim 12, as follows<sup>1</sup>:

“said connecting means including a first threaded stud outwardly projecting from a top end of said stanchions in substantially axial alignment therewith enabling each of said upper side rails to be rotatably mounted thereon at various angles,

said upper side rails being pivoted in a vertical plane at varying angles by ~~use of angulation means~~,

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<sup>1</sup>The strikethrough and underlining show the changes made in each reissue claim relative to the cover piece limitation as it existed in the original patent claims.

~~said angulation means comprising a generally L-shaped swivel bracket disposed on said first threaded stud at said top end of said stanchions, said L-shaped bracket including a long leg portion and a short leg portion being fixedly attached in perpendicular relation thereto, said bracket further including swiveling means being adapted for pivoting movement in a plane parallel to the plane defining said long leg portion, said swiveling means including a second threaded stud disposed in perpendicular relation to said axis of said stanchion enabling said upper side rails to be mounted thereon and pivoted in a vertical plane at varying angles for installation of said temporary guardrail system on inclines such as stairs."~~

Original application claim 1 was drawn to a temporary guardrail system having vertical stanchions and upper and lower side rails and included a broadly claimed *means for rotatably connecting* said rails to said stanchions. Original application claim 2 which depended from claim 1 added the limitation that the connecting means included a "axially threaded stud" for rotatable connection of the side rails. Original application claim 3 which depended from claim 1 added the limitation that the connecting means included angulation means, and original application claim 4 which depended from application claim 3 added the specific L-shaped bracket structure of the angulation means. These limitations were all added to claim 1 in the amendment of December 2, 1997, (paper No. 12). It is clear from the remarks on page 3 of the December 2, 1997, amendment that applicant gave up the broad rotatably connecting structure of application claim 1, and relied upon the inclusion into application claim 1 of the above noted limitations of application claims 2, 3 and 4 as the basis for obtaining the patentability of patent claim 1.

The reissue claims broaden the limitation of the "*means for rotatably connecting*" in patent claim 1 by deleting the "angulation means" (of original application claim 3) and the specific "L-shaped bracket structure" (of original application claim 4) while retaining the "axially threaded stud" limitation (of original application claim 2) for rotatable connection of the side rails. Because the limitations of claim 2 remain in reissue claim 12, the reissue claim is still narrower than the canceled claims (i.e., the claims before any limitations to the "*rotatably connecting*" was added to obtain allowance). Thus, the reissue claims provide a narrowing of the canceled claims in the area of the surrender.

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4. Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

***Conclusion***

5. This application is in condition for allowance except for the following formal matters: The original patent, or a statement as to loss or inaccessibility of the original patent, must be received before this reissue application can be allowed. See 37 CFR 1.178.

Prosecution on the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

A shortened statutory period for reply to this action is set to expire **TWO MONTHS** from the mailing date of this letter.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to William L. Miller whose telephone number is 703 305 3978. The examiner can normally be reached on Tuesday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, J. J. Swann can be reached on 703 306 4115. The fax phone number for the organization where this application or proceeding is assigned is 703 872 9326.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703 308 1113.

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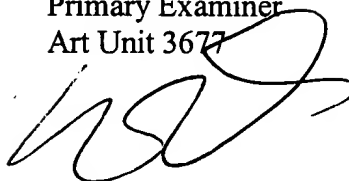
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William L. Miller

Primary Examiner

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A handwritten signature in black ink, appearing to be 'WLM', written over the printed name and title.

WLM

12-03-2003